



15 SEP 2003

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In re Application of	:	
Topaloglou et al.	:	
US Application No.: 10/018,461	:	DECISION ON PETITION
PCT Application No.: PCT/IB00/00863	:	UNDER 37 CFR 1.137(b)
International Filing Date: 28 June 2000	:	AND REQUEST UNDER
Priority Date: 29 June 1999	:	37 CFR 1.497(d)
Attorney's Docket No.: GLC0007-US	:	
For: BIOLOGICAL DATA PROCESSING	:	

This decision is in response to the petition to revive the above-referenced application under 37 CFR 1.137(b), filed on 09 June 2003; and the "Petition for Correction of Inventorship under 37 CFR 1.48(a)" filed on 16 December 2002, which is being properly treated as a request under 37 CFR 1.497(d). As discussed below, the §1.137(b) petition is **DISMISSED**, however, the §1.497(d) request is **GRANTED**.

### BACKGROUND

On 28 June 2000, Applicant Thodoros TOPALOGLOU filed international application PCT/IB00/00863, which claimed priority of an earlier application filed on 29 June 1999. A copy of the international application was communicated from the International Bureau to the USPTO on 04 January 2001. A demand for international preliminary examination, in which the United States was elected, was filed on 28 January 2001, prior to 29 January 2001, the end of the 19-month period from the 29 June 1999 priority date. The period for paying the basic national fee is thus 30 months and ended at midnight on 29 December 2001.

On 19 December 2001, a transmittal letter for entry into the national stage in the United States (Form PTO-1390), along with, *inter alia*, a \$430 check for payment toward the \$445 basic national fee (small entity) required by 35 U.S.C. 371(c)(1) and 37 CFR 1.492(a)(5), an authorization for the USPTO to charge the \$15 deficiency to Deposit Account No. 50-1458, and an unexecuted declaration identifying an additional inventor, Anthony KOSKY, without stating his country of citizenship.

On 08 March 2002, a "Notification of Missing Requirements under 37 CFR 371 in the United States Designated/Elected Office (DO/EO/US)" (Form PCT/DO/EO/905) was mailed, stating that the unexecuted declaration did not comply with 37 CFR 1.497(a) and (b), and

requesting submission of a proper oath or declaration within the later of 2 months from the mailing date of the notification (i.e., 08 May 2002), or, 32 months from the priority date (i.e., 28 February 2002). The reply period was extendable under 37 CFR 1.136(a). In other words, a proper response to the 08 March 2002 Notification of Missing Requirements must be filed, at the latest, on or before **08 October 2002** with the 5-month maximum extension of time and the requisite fee.

On 29 July 2002, 2 executed declarations, to be discussed below, were filed along with a request for a 3-month extension of time, the requisite extension-of-time fee, and the \$65 surcharge (small entity) for lacking a proper declaration before commencement of the national stage. These declarations do not indicate Anthony KOSKY's country of citizenship.

On 14 November 2002, a "Notification of Defective Response" (Form PCT/DO/EO/916) was mailed, pointing out that the 29 July 2002 declarations indicate an additional inventor not identified in the published international application. This notification in effect required submission of an oath or declaration, in compliance with 37 CFR 1.497(a) and (b), within an unextendable 1 month of the mailing date of this notification (i.e., on or before **16 December 2002 (Monday)**), since the maximum extendable reply period under the 08 March 2002 Notification of Missing Requirements had expired by then.

On 16 December 2002, a response was timely filed along with a petition to add Anthony KOSKY as an inventor. This petition did not enclose a supplemental declaration adding Anthony KOSKY's country of citizenship.

On 08 April 2003, a second "Notification of Defective Response" (Form PCT/DO/EO/916) was mailed, stating that the filed declarations did not identify Anthony KOSKY's country of citizenship. This second Form PCT/DO/EO/916 in effect requested submission of an oath or declaration, in compliance with 37 CFR 1.497(a) and (b), within an unextendable 1 month of the mailing date of this notification, i.e., on or before **08 May 2003**.

A response was not filed on or before 08 May 2003. The international application became abandoned as to the United States on 09 May 2003.

### DISCUSSION

#### Petition under 37 CFR 1.137(b)

The petition encloses the \$650 petition fee (small entity), and a statement to the effect that the entire delay in supplying an oath or declaration in compliance with 37 CFR 1.497(a) and (b) from its due date until the filing of the instant §1.137(b) petition was unintentional. In addition, a terminal disclaimer is not applicable in the instant case.

However, the supplemental declaration submitted with the instant petition, though identifying Anthony KOSKY's country of citizenship and signed by him, is nevertheless defective for showing Anthony KOSKY as the "sole or first inventor" without also listing Thodoros TOPALOGLOU as the joint inventor. 37 CFR 1.497(a)(3).

Consequently, the §1.137(b) petition is **DISMISSED** for lacking the "reply" required by 37 CFR 1.137(b)(1). MPEP 711.02(a) (Rev. 1, Feb. 2003).

Request under 37 CFR 1.497(d)

As stated above, the 19 December 2001 Form PTO-1390 was accompanied by a declaration that included a second inventor, Anthony KOSKY, not shown as an inventor in the published international application. The instant request specifically seeks to add Anthony KOSKY as an inventor for this application.

Under 37 CFR 1.497(d), an inventor may be added or deleted from the inventive entity named in the international application provided that an oath or declaration naming the new inventive entity is filed, accompanied by: (1) a statement from the person being added or deleted, that any error in inventorship in the international application occurred without deceptive intention on his/her part; (2) the processing fee set forth in 37 CFR 1.17(i); (3) the assignee's written consent, if an assignment has been executed by any of the original named-inventors.

The instant request encloses, *inter alia*:

- (1) A statement from Anthony KOSKY that the error in omitting his name as an inventor from the international application occurred without deceptive intention on his part;
- (2) The \$130 processing fee; and
- (3) A written consent by the assignee of record, along with a copy of the assignment evidencing this assignee's ownership of the entire interest in this application.

Moreover, 2 supplemental declarations were filed on 29 July 2002, each indicating both Thodoros TOPALOGLOU and Anthony KOSKY as inventors. Of the 2 supplemental declarations, 1 was signed by Thodoros TOPALOGLOU and the other by Anthony KOSKY.

The request under 37 CFR 1.497(d) is thus **GRANTED**. Anthony KOSKY is added as an inventor in this application.

CONCLUSION

The §1.137(b) petition is **DISMISSED without prejudice**. A renewed §1.137(b) petition must be filed within **TWO MONTHS** of the mailing date of this decision. The period is extendable under 37 CFR 1.136(a).

The §1.497(d) request to add a second inventor is **GRANTED**.

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